



UNITED STATES DEPARTMENT OF COMMERCE  
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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---------------|-------------|-----------------------|---------------------|
| 06/853,404    | 04/18/86    | FISHER                | FIS-848-VA          |

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| EXAMINER |              |
|----------|--------------|
| BONDY, R |              |
| ART UNIT | PAPER NUMBER |
| 1.2.9    | 6            |

DATE MAILED: 10/20/87

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948.       |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449                  | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474      | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-54, 57-86 and 88-100 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-55, 57-86 and 88-100 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable;  
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☒ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☒ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

(two documents)

Serial No. 2853,404

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Art Unit 129

Claims 1-54, 57-86 and 88-100 are now in the case.

The status of the application is that it is being rejected on 15 Oct 1987.

A total of 97 claims are now pending.

Claims 1-54, 57-86 and 88-100 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "quinuclidine derivatives having the general formula (I)" should be deleted and replaced by the terms "A compound of the formula". This is because the term "quinuclidine" is redundant in view of the formula. Also, the terms "derivatives" and "general" imply the presence of unnamed substituents.

"Z" cannot represent "the group  $>CR^1R^2$  or two hydrogen atoms". The two hydrogen atoms must be  $R^1$  and  $R^2$ . They cannot be present absent attachment to a carbon atom.

The terms "alkyl", "aryl", "diarylmethylol" and alkyl which is substituted by one or more aryl groups" encompass compounds or groups having any number of carbon atoms. The terms "aryl" and terms derived from "aryl" also encompass any number and type of unnamed substituent. The terms "one or more" have no upper limit.

The terms "quinuclidine derivatives" are redundant at best and misleading. These terms have already been criticized above.

The terms "quinuclidine derivative" are also redundant and misleading. Any unnamed substituents are encompassed by these terms.

The terms "pharmaceutical" is too vague and indefinite to constitute a utility. The composition and method of use claims should recite a specific use or uses. Also, proportions of ingredients should be recited. This may be done by the use of functional language, if supported by the specification. Such support appears to be abundant but it must be utilized and specifically pointed out.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 18-41 are rejected under 35 U.S.C. 103 as being unpatentable over Cohen et al.

Serial No. 853,404

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Art Unit 129

The process of reacting an aldehyde or ketone with 3-hydroxymethyl-3-quinuclidine to form a 2 methyl spiro (1,3-dioxolane-4,3<sup>1</sup>) quinuclidine is entirely analogous with the process claimed.

The process claims are drawn to subject matter obvious to one of ordinary skill in the art within the meaning of 35 USC 103.

In regard to the obviousness of the subject matter of claims 18-41, see In re Albertson, 141 USPQ 730. The reasoning of In re Albertson was reaffirmed. See In re Durden, Jr. 226 USPQ 359 (CAFC, 1985).

Note that new drawings are required.

Any inquiry concerning this communication should be directed to Robert T. Bond at telephone number 703-557-3432.

RTBond:pw

A/C 703

557-3432

10/19/87

*Robert T. Bond*

ROBERT T. BOND  
PRIMARY EXAMINER  
ART UNIT 129